

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Regarding: Leslie E. Smith et al.
Serial No. 10/743,936
Filing Date 12/23/2003
For FORMATION OF WIDE PAINT FILM PARTS

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Request for Rehearing in Appeal No. 2006-3109

Appeal from Technology Center 1700 Art Unit 1732
Examiners Monica A. Fontaine and Michael P. Colaianni

Commissioner for Patents, Alexandria, VA 22313-1450:

I certify that this correspondence is facsimile-transmitted
to the Patent and Trademark Office (571 273 8300) on 16 JAN 2007:

Christopher John Rudy: *Christopher John Rudy* 16 JAN 2007.

Please consider the present request in reply to the DECISION
ON APPEAL (decision) decided on November 14, 2006. The opinion
with reasoning of the decision is respectfully traversed.

Reconsideration Argument

Among the points believed to have been misapprehended or
overlooked by the Board are the following:

A. Specific arguments were set forth, and overlooked.

On page 3 of the decision it was stated that arguments
reasonably specific to any particular claim on appeal were not
set forth so that all the appealed claims stood or fell together.
The record shows that the Appellant set forth otherwise.

To begin with, claim 12 was separately argued against a
combination of references that included Ghosh, US 6487902, in the
main brief under a separate heading in bold-face type, and also
in the reply brief. See, the Amended Brief filed on November 15,
2005, from the middle of page 6 to the top line of page 8; and
the Reply Brief filed on February 23, 2006, paragraph bridging
pages 2 and 3, and page 3, first and second full paragraphs.

The decision failed to address the limitations of claim 12.

The decision failed to address the arguments in support of
the patentability of claim 12. Note that the decision failed to
mention Ghosh in its discussion on the merits of its opinion.

Furthermore, a discussion of dependent claims 11, 20, 21, 25,
28 and 31 was set forth with specificity in the main brief. See,
the Amended Brief, paragraph bridging pages 5 and 6.

A discussion of dependent claims 21-31 was separately set
forth too. See, the Amended Brief, page 6, first full paragraph.

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Clearly, the Board did not "thoroughly review" the arguments.

All claim limitations must be considered. See, e.g., In re Saether, 492 F.2d 849 [181 USPQ 36, 39] (CCPA 1974). Arguments of the Appellant cannot be ignored. Compare, In re Rijckaert, 9 F.3d 1531 [28 USPQ2d 1955, 1956] (Fed. Cir. 1993).

B. The level of ordinary skill in the art was not resolved.

The decision consistently refers to "one of ordinary skill in the art," but a level of skill for that hypothetical person was not resolved. Graham v. John Deere Co. of Kansas City, 383 U.S. 1 [148 USPQ 459, 467] (1966), however, requires its resolution.

C. Claim limitations were misapprehended or overlooked.

Among the limitations misapprehended or overlooked was that of a laminated paint film sheet stock being employed to form wide paint film parts, with that stock stretched to form a planarly drawn or stretched laminate paint film sheet that retains a painted surface finish. See, claim 1. The decision, however, consistently refers to "film stock that is painted," and also to such things as "latex paint" and "non-latex paint," which shows a fundamentally flawed understanding of the claimed invention. Even an ordinary artisan would recognize that stock or film stock which is painted is not the equivalent of laminated paint film sheet stock.

Furthermore, overlooked was the limitation of claim 12 that the laminated paint film sheet stock be stretched 125% or more. The limitations within claims 11, 20, 21, 25, 28 and 31 (heat) and claims 21-31 (stretching parameters) were overlooked also.

All claim limitations must be considered. See, e.g., Saether, 492 F.2d 849 [181 USPQ at 39].

D. Teachings of the art were misapprehended or overlooked.

The method of Petersen is not like that of the Appellant.

Petersen, US 2759217, does not disclose "a method for forming wide film parts." Even the Examiners admitted this. No film is used there. Rather, Petersen employs monolithic sheet stock. Sheet stock is not the equivalent of a film, and monolithic sheet stock is not the equivalent of laminated sheet stock, much less laminated paint film sheet stock where a deformable substantially planar sheet stock base has a paint film laminated thereon.

The prior art does not disclose effective thermal stretching of a paint film sheet stock in a planar manner.

Susa, US 5760122, does not disclose thermally deforming and stretching a painted film in a planar manner. First, Susa does

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not concern a painted film; rather it concerns vacuum molding of a sheet stock paint film laminate. Second, the molding of Susa is three-dimensional; a two-dimensionally stretched planar sheet stock paint film laminate is not disclosed. In Susa, the word, "stretching," merely refers to a defective portion of a contour molded product. Susa addressed the problem by a new composition.

Petersen and Susa are not combinable; they are in different technical fields. They clearly address different problems and needs, divergent from those the Appellant addresses. See, In re Oetiker, 977 F.2d 1443 [24 USPQ2d 1443, 1445] (Fed. Cir. 1992).

It is not up to the Appellant to advise the Board why Petersen is applicable to "only non-painted films." Rather, it is up to the Examiner and Board to support why Petersen should be applied, with a convincing line of reasoning for its application with Susa (and Ghosh); the record is devoid of that. See, id.; note, Ex parte Clapp, 227 USPQ 972, 973 (Bd. App. 1985). Even so, the Appellant has amply apprised the Examiners and Board of practical reasons why one of ordinary skill in the pertinent art of laminated paint film sheet stock forming would not turn to Petersen for guidance: Petersen, when a plastic material is employed in that method, makes airplane windshields. It is entirely against such an intent of that reference to eliminate or obscure visibility in a cockpit windshield, which painting or use of a stretched laminate paint film stock would do. Moreover, a monolithic sheet such as for an aircraft windshield or made of beryllium metal for another purpose has significantly different characteristics than does a laminate paint film sheet stock. The intents of a reference cannot be destroyed to establish a prima facie case of obviousness. See, In re Gordon, 733 F.2d 900 [221 USPQ 1125, 1127] (Fed. Cir. 1984).

Furthermore, as submitted above, employment in the decision of the phrase, "non-painted films," again belies the serious lack of understanding of the art exhibited on the part of the Board.

Ghosh was not addressed on the merits by the Board.

E. Other holdings of law were misapprehended or overlooked.

Teachings away in the cited patents were overlooked, and these provide strong evidence of unobviousness. The whole of the references must be considered, not just a part of them. Compare, In re Hedges 783 F.2d 1038 [228 USPQ 685, 687] (Fed. Cir. 1986); Gordon, 733 F.2d 900 [221 USPQ 1125, 1127].

It may have been obvious to try the method claimed by the Appellant, but "obvious to try" is not a sufficient standard to establish a prima facie case of obviousness. See, In re Goodwin, 576 F.2d 375 [198 USPQ 1, 3] (CCPA 1978).

The Board's rationale to support the rejections, for example,

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in the paragraph bridging pages 4 and 5 of the decision is based on a misapprehension of the art, and abstractions, none of which is practical, all of which lack common sense. This is improper. See, e.g., Oetiker, 977 F.2d 1443 [24 USPQ2d 1443, 1445].

The case of In re Boesch, 617 F.2d 272 [205 USPQ 215, 219] (CCPA 1980), does not support the decision. First, no prima facie case was made out here. Second, the amount a laminated paint film sheet stock can be stretched and retain its finish betokens the definiteness of the claims, not any obviousness of them. Third, the facts of Boesch are not commensurate with the present facts. And finally, the citation of the case is an attempt to make out a case of obviousness, not by the facts, properly understood, and applicable law, but by a per se rule, which is improper, and should have ceased over a decade ago. See, e.g., Rijckaert, 9 F.3d 1531 [28 USPQ2d 1955 at 1956]; In re Brouwer, 37 F.3d 422 [37 USPQ2d 1663, 1666] (Fed. Cir. 1996); In re Ochiai, 71 F.3d 1565 [37 USPQ2d 1127, 1133] (Fed. Cir. 1995).

No evidence of secondary considerations was entered under 37 CFR 1.132. None was needed. No prima facie case was made out. Compare, Rijckaert, 9 F.3d 1531 [28 USPQ2d 1955 at 1956].

Conclusion

The opinion and reasoning of the Board and the Examiners are in reversible error. Please, therefore, reconsider and reverse the DECISION ON APPEAL and the rejections of the Examiners, and allow this application.

Respectfully,

LESLIE E. SMITH ET AL.

Date: January 16, 2007 A.D.

By



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